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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,324	02/23/2004	Peter R. Nuytkens	12569-108DIV	8708
26486	7590	06/27/2006	[REDACTED]	EXAMINER
PERKINS, SMITH & COHEN LLP				KIM, PAUL D
ONE BEACON STREET				
30TH FLOOR			ART UNIT	PAPER NUMBER
BOSTON, MA 02108				3729

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/784,324	NUYTKENS ET AL.	
	Examiner Paul D. Kim	Art Unit 3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 April 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
  - 4a) Of the above claim(s) 10-12 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,4-6 and 9 is/are rejected.
- 7) Claim(s) 2,3,7 and 8 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 23 February 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/17/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

This office action is a response to the election of species filed on 4/14/2006.

### ***Response to the Election of Species***

1. Applicant's election without traverse of Species A, drawn to Fig. 22 for claims 1-12, in the reply filed on 4/14/2006 is acknowledged. However, examiner traverses the election for the Species A, drawn to Fig. 22. Fig. 22 shows the inductor core formed on the printed circuit board, which is recited in claim 9. On the other hand, Fig. 25 as for Species B shows the inductor core formed on the multichip module, which is recited in claim 10, and Fig. 26 as for Species C shows the inductor core formed on the integrated circuit, which is recited in claim 11, and Fig. 27 as for Species D shows the inductor formed on the micro-electromechanical device, which is recited in claim 12. Therefore, claims for the elected Species A, drawn to Fig. 22, are 1-9.
2. Claims 10-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4/14/2006.

### ***Oath/Declaration***

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The mailing address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either an application data sheet or supplemental oath or declaration.

### *Drawings*

4. The drawings are objected to because the reference number "134" in Fig. 10 is not clear what the reference number "134" is indicated. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and

informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Objections***

5. Claims 1-9 are objected to because of the following informalities:

Re. Claim 1: The phrase "the surface" as recited in line 1 appears to be –a surface--.

The phrase "a surface of a dielectric material" as recited in line 3 appears to be –the surface of the dielectric material--.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "said ferromagnetic material" as recited in line 1 lacks antecedent basis. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 1, 4-6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Portner (US PAT. 5,288,313) in view of Woo et al. (US PAT. 6,228,768).

Portner teaches an electroless plating process for EMI shielding (equivalent with printed circuit board as per claim 9) for electronic components comprising steps of dipping a surface of a dielectric material (such as plastic) in a solution containing catalytic metal particles such as noble metals having a slight electrostatic dipole moment when in solution to help the particles attach to the surface of the dielectric material; and immersing the catalyzed surface of the dielectric material in a metal solution so as to cause a layer containing metal to be plated upon the surface of the dielectric material containing the catalytic metal particles by a process of electroless plating (also see col. 3, line 66 to col. 4, line 31).

However, Portner fail to teach to place the catalyzed surface of the dielectric material in a metal salt solution with a reducing agent. Woo et al. teach an electroless plating process including a process of immersing the catalyzed surface in a metal salt solution with a chemical reducing agent in order to reduce the metal ions in the plating solution (see col. 2, lines 29-47). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify a process of

immersing the catalyzed surface of the dielectric material in a metal solution of Portner by immersing the catalyzed surface in a metal salt solution with a chemical reducing agent as taught by Woo et al. in order to reduce the metal ions in the plating solution.

As per claim 6 Portner teaches that the catalytic particles of are one of palladium, ruthenium, rhodium and platinum.

***Allowable Subject Matter***

10. Claims 2, 3, 7 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul D. Kim whose telephone number is 571-272-4565. The examiner can normally be reached on Monday-Friday between 6:00 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Paul D Kim  
Primary Examiner  
Art Unit 3729